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10/038,346	01/02/2002	Michael L. Obradovich	9800.1028	8390

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EXAMINER

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ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 10/038,346
Filing Date: January 02, 2002
Appellant(s): OBRADOVICH, MICHAEL L.

Alex L. Yip
For Appellant

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EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/10/2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's grouping of claims is incorrect. Claims 129-137, 138-146 and 148-154 are pending; claims 1-128 have been cancelled.

The rejection of claims 129-137, 139-146 and 148-154 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,790,973	Blaker et al.	8-1998
5,859,628	Ross et al.	1-1999
6,028,537	Suman et al.	2-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 129-137, 139-146 and 148-154 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross in view of Suman. Claims 129-137, 139-146 and 148-154 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Blaker in view of Suman. These rejections are set forth in prior Office Action, Paper No. 12.

(11) Response to Argument

Appellant's first argument asserts that the Examiner has failed to establish a *prima facie* case of obviousness utilizing Blaker in view of Suman. After a brief synopsis of the prior art, the appellant asserts that the particular limitation lacking in the rejection of Blaker in view of Suman is "selecting the closer service provider to provide maintenance service when the closer service provider is within a predetermined distance from [sic] the current location of the vehicle." (See Brief at page 5).

Suman teaches in columns 33-36, specifically in column 34, lines 59-65, that the closer service provider (S₁) is selected when the closer service provider is within a

predetermined distance (a distance less than the range of the vehicle) and the second service provider (S_2) is at a distance greater than the range of the vehicle (distance to empty). In the Suman invention, the predetermined distance is the range of the vehicle determined by the processor to be the distance to empty, the maximum distance the vehicle can continue without running out of fuel. As seen in figure 43 of Suman, this distance is calculated beforehand, i.e. predetermined, in step 658, before the selection of the closest service provider in step 662. The distance to the closest service provider S_1 must be less than the predetermined distance, or else the vehicle would not be able to reach the selected service facility and the explicit purpose of the Suman invention (see column 35, lines 47-51) would be rendered pointless.

Appellant's second argument asserts that the Examiner has failed to establish a *prima facie* case of obviousness utilizing Ross in view of Suman. After a brief synopsis of the Ross reference, the appellant asserts that the rejection stands or falls with the prior argument with respect to the deficiencies of the Suman reference. The Examiner also relies on the previous explanation of the Suman reference outlined in detail above.

Appellant's third argument asserts that the Examiner agreed on the record that the claimed invention is distinguishable over Blaker and thereafter improperly rejected the same claimed invention based on an identical disclosure to Blaker in Suman. The most cursory review of the 5,790,973 patent to Blaker and the 6,028,537 patent to Suman would indicate that they are not identical disclosures. While they share the same assignee and are based on the same last exit warning system, the two references are distinct inventions. Statutory double-patenting laws prohibit a result otherwise. The

Suman reference contains a much more thorough and detailed disclosure and represents an improvement over the earlier system disclosed in the Blaker reference.


Finally, there does not exist in the law a doctrine of Examiner estoppel under which relief can be granted. The Examiner's statement that he "agrees with Applicant" with respect to the 35 U.S.C. § 102 rejection (see Appendix C, page 5) cannot preclude the Examiner from using a similar but distinct reference in a subsequent 35 U.S.C. § 103 rejection. In fact, the rejection to which the Examiner's statement is attributed is no longer the prevailing rejection of record and therefore the issue should be moot. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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January 14, 2004

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